

Appl. No. 09/865,989
Amdt. dated September 10, 2003
Reply to Office Action of July 11, 2003

REMARKS

Claims 76-103 are pending and under consideration in the instant application. With this response, the specification and Claims 76 and 84-86 have been amended. Claim 77 has been canceled. After entry of the instant amendment, Claims 76 and 78-103 are pending and under consideration.

III. AMENDMENT OF THE SPECIFICATION

The specification has been amended to include a proper priority benefit claim. Applicants submit herewith a Petition to Accept an Unintentionally Delayed Claim for Priority under 37 CFR. §1.78. If the Petition is granted, Applicants respectfully request entry of the amendment to the specification.

IV. AMENDMENT OF THE CLAIMS

Claim 76 has been amended, in relevant part, to recite, that at least one L-enantiomeric residue of formula I is replaced with an identical D-enantiomeric residue. Support for amended Claim 76 can be found in Claim 1 as originally filed and page 44, lines 15 to 29.

Claims 84-86 have been amended to correct dependency. Claims 85 and 86 were also amended to correct the formula for 'X.' Support for amended Claims 84-86 can be found in Claims 16-18 as originally filed.

Applicants submit that currently amended Claims 76 and 84-86 are fully supported by the specification and do not introduce new matter. Applicants respectfully request entry of the amendments.

V. PRIORITY

The PTO acknowledges the claim for domestic priority under 35 U.S.C. §120 to Application Serial No. 09/465,719, filed December 17, 1999. Application Serial No. 09/465,719 is a continuation of Application Serial No. 08/940,093, filed September 29, 1997. Applicants did not identify all applications and their relationship in their priority claim. The error was unintentional. Applicants submit herewith a Petition to Accept an Unintentionally Delayed Claim for Priority under 37 CFR. §1.78. Upon

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acceptance of the petition, Applicants request that the specification be amended, as discussed, above.

VI. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 84-103 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite because Claims 84-86 depend upon canceled Claim 1. Applicants have amended Claims 84-86 to change dependency, as discussed above.

Applicants submit that Claims 84-103 are definite and respectfully request that the rejection be withdrawn.

VII. OBJECTION

Claims 76-103 are objected to for alleged redundancy as to X_1 being Pro or D-pro with the recitations that at least one residue of the peptide or peptide analogue can be a D-enantiomeric residue.

Applicants have amended Claim 76, as discussed above, to recite, in relevant part, that at least one L-enantiomeric residue of formula I is replaced with an identical D-enantiomeric residue. Claim 77 has been canceled. Applicants submit that Claims 76 and 78-103 are not redundant and respectfully request that the objection be withdrawn.

VIII. DOUBLE PATENTING

Claims 76-103 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over U.S. Patent Nos. 6,265,377 and 6,037,323.

A. U.S. Patent No. 6,265,377

Claims 76-103 stand rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-48 of U.S. Patent No. 6,265,377 ("the '377 patent"). The PTO contends that although the conflicting claims are not identical, they are not patentably distinct because the '377 patent allegedly anticipates the claims of the subject application in that the '377 patent claims compounds having the same structure and amino acid sequence in which X_1 can be D-pro. Applicants have amended Claim 76, as discussed above and submit that the pending Claims are patentable over the

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Claims of the '377 patent. In addition, Applicants have submitted a Petition, to correct the claims for domestic priority, as discussed above. Applicants respectfully request that the rejections be withdrawn.

B. U.S. Patent No. 6,037,323

Claims 76-103 stand rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-54 of U.S. Patent No. 6,037,323 ("the '323 patent"). The PTO contends that although the conflicting claims are not identical, they are not patentably distinct because the '323 patent allegedly anticipates the claims of the subject application in that the '323 patent claims compounds having the same structure and amino acid sequence in which X₁ can be D-pro. Applicants have amended Claim 76, as discussed above and submit that the pending Claims are patentable over the Claims of the '323 patent. In addition, Applicants have submitted a Petition, to correct the claims for domestic priority, as discussed above. Applicants respectfully request that the rejections be withdrawn.

IX. CLAIM REJECTION UNDER 35 U.S.C. §102

A. 35 U.S.C. §102 (e)

Claims 76, 78, 83, 92, 94 and 95 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Dassuex *et al.* (U.S. Patent No. 6,004,925 "the '925 patent").

Applicants submit that Claims 76, 78, 83, 92, 94 and 95 are not anticipated by the '925 patent. Applicants have amended Claim 76, as suggested by the PTO and discussed above. In addition, Applicants submit herewith a Petition to Accept an Unintentionally Delayed Claim for Priority under 37 CFR. §1.78. Applicants respectfully request that the rejection be withdrawn.

B. 35 U.S.C. §102 (a)

Claims 76, 78, 83, 92, 94 and 95 stand rejected under 35 U.S.C. §102(a) as allegedly anticipated by WO Publication 99/16459 (Dasseux *et al.* "the '459 application").

Applicants submit that Claims 76, 78, 83, 92, 94 and 95 are not anticipated by the '459 application. Applicants have amended Claim 76, as suggested by the PTO and discussed above. In addition, Applicants submit herewith a Petition to Accept an Unintentionally

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Delayed Claim for Priority under 37 CFR. §1.78. Applicants respectfully request that the rejection be withdrawn.


CONCLUSION

Applicants submit that Claims 76 and 78-103 satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same and passage of Claims 76 and 78-103 to issuance is therefore kindly solicited.

No fee, other than the Petition Fee under 37 C.F.R. § 1.17(t), is believed due in connection with this response. However, the Commissioner is authorized to charge all required fees, other fees under 37 CFR § 1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP U.S. Deposit Account No. 16-1150 (Order No. 9196-019-999).

Respectfully submitted,

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 42,983

Rahul Pathak (Reg. No.)

For: Laura Coruzzi 30,742

PENNIE & EDMONDS LLP

1155 Avenue of the Americas

New York, New York 10036-2711

(212) 790-9090